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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,523	04/18/2001	Claude Debroche	34213-071556.0172	8187

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BAKER BOTTS L.L.P.
44TH FLOOR
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-4498

EXAMINER

KNABLE, GEOFFREY L

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,523

Applicant(s)

DEBROCHE, CLAUDE

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. Applicant's election with traverse of group I, claims 1-4 (now 1, 3-4) in Paper No. 8 is acknowledged. The traversal is on the ground(s) that there is no burden to search and examine both groups in the same application. This is not found persuasive because the potential other devices that could be used to practice the claimed method (relative to the very specifically claimed apparatus) makes the considerations in search and examination of the two groups significantly different, this presenting a significant burden to search and examine both groups in the same application.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 5-8 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

3. Claims 1, 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to define that the knife is "advanced to cut at the cutoff point at every n passage," this language differing from the originally described and claimed invention that indicated that the knife is "active" at the cutoff point every n passage. Although the original disclosure does refer to "advancing" the knife to cut, this is only in the context of the figs. 5-6 embodiment. It would appear however from an

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examination of applicant's complete response that there is no intent to limit the invention to the figs. 5-6 embodiment, or stated another way, the reference to figures 3 and 4 in the response (particular the discussion of the 112 rejection) indicates that applicant appears to intend that the present claims are still to be read as consistent with that embodiment as well. To the extent that the claims as amended are to be so read, such is not considered to have been described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter. In other words, describing that the knife is "advanced" to cut is only considered consistent with the figs. 5-6 embodiment (as this term is only used in the context of this embodiment) and inconsistent with the other embodiment, the apparent intended more generic reading therefore being not described. It is noted however that other language that is explicitly supported (e.g. such as the originally used "active" or the also used term "presented") would avoid this rejection.

Claim 1 has also been amended to define that the knife is caused to "move in one way". This language was apparently not used in the original disclosure and it is therefore not entirely clear what is intended to be conveyed by this terminology, this making it difficult to determine whether this was described. In any event, since this language was not originally used, absent some convincing explanation to the contrary, it is not considered to be described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. is considered to be new matter.

4. Claims 1 and 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As noted above, claim 1 has been amended to define that the knife is caused to move "in one way". It however is not clear what is being defined by this requirement such that the scope of protection is indefinite. Note for example this could be read as referring to a direction of motion or a manner of motion – the lack of any original use of this terminology rendering it impossible to determine what is intended and thus the scope cannot be readily ascertained.

Additionally, in addition to the new matter with respect to the reference to "advanced", it is also not entirely clear what the scope of this is assuming that the claims are to be read as not only consistent with the figs. 5-6 embodiment but also the figs. 3-4 embodiment. In other words, the use of the term "advanced" in a manner inconsistent with that originally described (which only used it in the context of figs. 5-6 where it is clear that the knife is "advanced") renders it difficult to determine the intended scope of protection afforded by the present claims.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Note: The new claim 1 requirement that the knife be "advanced" every n passage, if read consistent with the originally described use of this term (i.e. with reference to the figs. 5-6 embodiment) and thus requiring actual knife "advance", will require a new ground of rejection, necessitated by amendment, since such would define

over simply a rotating knife as in the applied prior art. If however the term "advanced" is to be read as simply synonymous with the original term "active", then the original or previous rejection would still be properly applicable (it being again stressed that defining that the knife is active every 2 passages does not exclude that the knife also be active every passage – if such were intended to be excluded, then the term "only" should have been used). Therefore, the ambiguity in this regard now requires that the examiner present rejections based on both interpretations. Thus, if "advanced" is read as consistent with both embodiments and thus synonymous with the original term "active", then the original/previous rejection is still properly applicable and will be maintained. If on the other hand, this term is to be read consistent with the original use of this term, then a new ground of rejection will be required. Both rejections therefore follow, the new rejection however being necessitated by the amendments to claim 1.

7. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Debroche et al. (US 5,281,289) or Debroche et al. (US 5,395,476) as applied in the last office action.

As noted above, contrary to applicant's arguments (and reading the term "advanced" as not inconsistent with a rotating knife that is periodically active), nothing in the present claims excludes a knife that is active at every passage. Again, a requirement that a knife is active every "n" passage does not say or require anything about what is happening during the other passages and thus cannot be read as inconsistent with a knife active during every passage. There is *no* claim 1 requirement that the knife be active "only" during every "n" passage.

8. Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Debroche et al. (US 5,281,289) or Debroche et al. (US 5,395,476) taken in view of Pavlov (US 4,640,164) and/or Puchovsky (US 6,032,560).

The Debroche et al. references are applied for substantially the same reasons as set forth in the last office action. As to the new requirement that the knife be "advanced" to cut at the cut off point every n passage, the Debroche patents show a rotatable knife that periodically is active in the cutoff zone but the knife is not actually "advanced" consistent with the originally disclosed use of this term (i.e. with reference to figs. 5-6).

In the art of continuous high speed cutting of wire/rods, however, it is well known to provide a rotating cutter that rotates at high speed in which the knife is selectively advanced to cut the material without having to slow the wire down – Pavlov (e.g. col. 5, lines 1-11) and Puchovsky are exemplary of two such known means to effect such high speed cutting. It is submitted that it would have been obvious to the ordinary artisan to adopt or adapt such well known high speed continuous (i.e. "on the fly") cutting devices to the continuous periodic cutting required or desired by the Debroche et al. patents, it being considered that it would have been understood by the ordinary artisan to have been clearly desirable in the Debroche et al. processes to utilize a cutting procedure that minimizes as much as possible interference with the continuous movement of the cords – note for example that Debroche et al. '476 indicates an understanding that the cord may stop for a brief instant during cutting and must take steps to counteract this (col. 4, lines 61+). A cutting procedure that is known to be as effective as possible at cutting without interfering with continuous movement would therefore have been

expected to be particularly desirable to utilize in processes such as in the Debroche patent for only the expected results. The claim requirement for advancing the knife every n passage, n being greater than or equal to 2 would have been the clear obvious adaptation of the prior art cutters to the Debroche et al. processes. In other words, since the cutters must rotate at very high speeds (and equal to the material speeds) and would certainly have been made smaller in circumference than the lengths to be cut, the obvious operation would have required actuation to advance the knife every n passage, n being greater than 2 as claimed. Note also col. 8, lines 29+ of Pavlov where provision of such suitable control relative to the number of rotations is known and conventional.

9. Applicant's arguments filed July 10, 2003 have been fully considered but they are not persuasive.

Applicants principally argue that the claims exclude a knife that is active on every passage. As noted above, however, claim 1 simply defines what happens every " n " passage and does not say or require anything about what is happening during the other passages and thus cannot be read as inconsistent with a knife active during every passage. In other words, there is *no* claim 1 requirement that the knife be active "only" during every " n " passage. The previous grounds of rejection is thus maintained as the arguments are not considered commensurate with the scope of the claims. Note however also the new ground of rejection necessitated by the inclusion of the term "advanced" in claim 1 and reading this consistent with the use of this term in the original disclosure (i.e. with respect to the figs. 5-6 embodiment) where it appears that more than simple blade rotation may be contemplated.

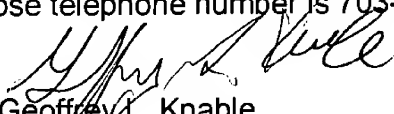
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
September 13, 2003